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JOHN F. DAVIS, CL

IN THE

Supreme Court of the United States

OCTOBER TERM, 1968

NO. ~~1014~~ 45

ANDERSON'S-BLACK ROCK, INC.,
Petitioner,

v.

PAVEMENT SALVAGE COMPANY, INC.,
Respondent.

BRIEF FOR RESPONDENT

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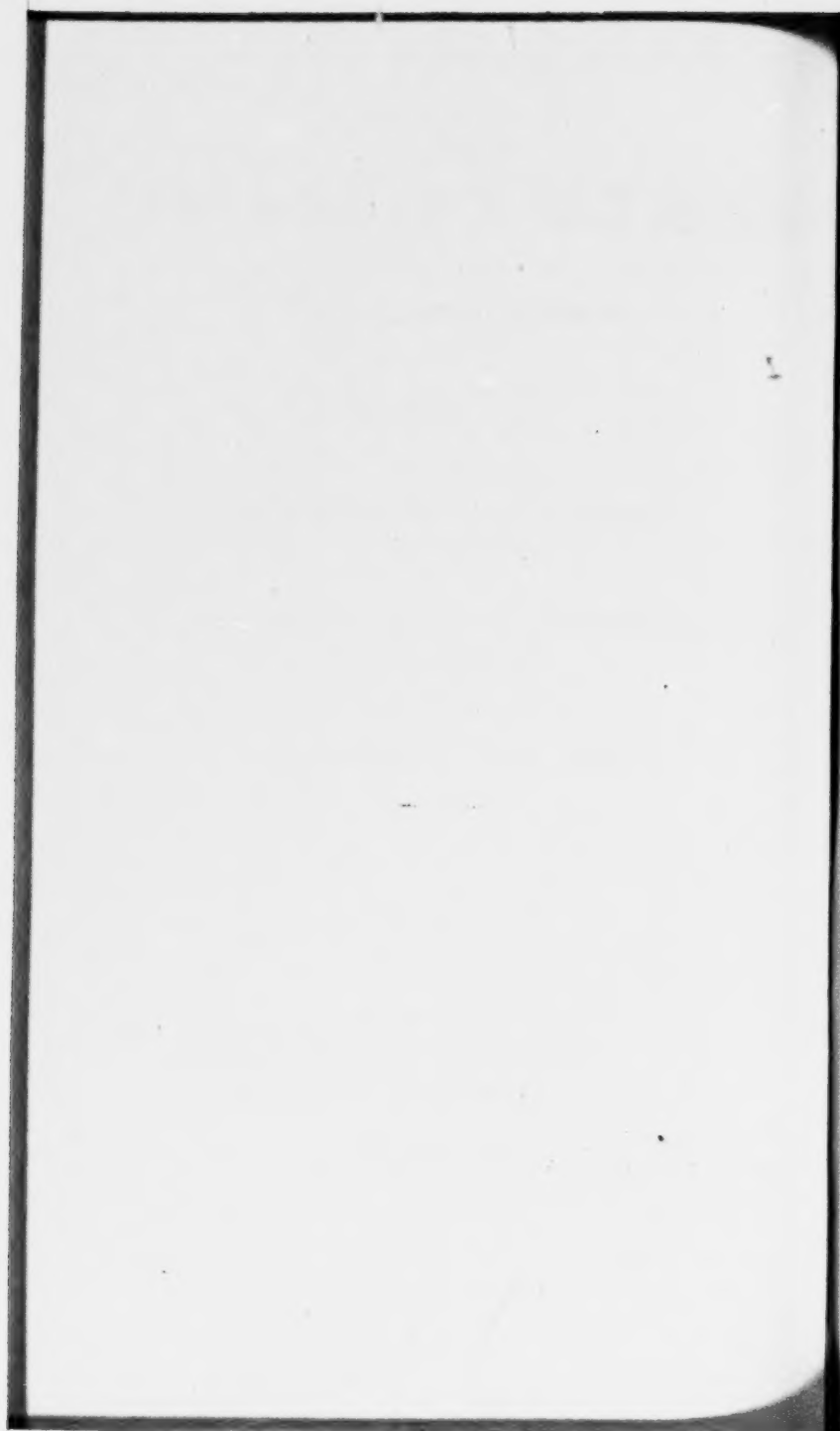


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BRIEF FOR RESPONDENT

— I —

The opinions below are correctly stated in Petitioner's Brief.

— II —

Jurisdiction is admitted.

— III —

STATUTES INVOLVED

This case additionally involves 35 U.S.C. §101, Act of July 19, 1952, c. 950, §1, 66 Stat. 797:

"Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title."

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— IV —

**COUNTERSTATEMENT OF QUESTIONS
PRESENTED**

1. Where a patent for paving apparatus claims a combination of elements which jointly act to solve a long-standing and troublesome problem in the paving art and the undisputed evidence is that the claimed solution to the problem was not an obvious one to those skilled in the paving art but eluded them, will the patent be held invalid merely because the elements of the combination are individually old?

2. Will a new combination of old elements, which combination is neither anticipated nor obvious and which produces a new and beneficial result, be held to be an unpatentable aggregation merely because the several elements of the combination are individually old.

— V —

STATEMENT OF THE CASE

1. *The proceedings below:*

This was an action by respondent for infringement of Neville Patent 3,055,280. The defense on behalf of Anderson's-Black Rock, Inc., was conducted by its equipment supplier, Aeroil Products, Inc.

The action was tried April 19-20, 1965, but by reason of illness of the District Judge was not decided until March 23, 1967.* In an unreported opinion (16-27a)† the trial judge acknowledged that the evidence

*The opinion is incorrectly dated in the Appendix as May 4, 1964 (16a).

†Page references are to the printed Appendix.

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in the case showed the claimed combination not to be obvious (24a). The trial judge nevertheless concluded (erroneously in respondent's submission) that in his opinion the claimed combination was an obvious one (24a). That conclusion is unsupported by any proof.

The trial judge also concluded (also erroneously in respondent's submission) that in his opinion the claimed combination in no way exceeds the sum of its parts (26a). That conclusion is also contrary to undisputed evidence in the case; and it is contrary to contentions made by Aeroil, the real defendant, outside of the courtroom.

The Court of Appeals, in an opinion dated November 22, 1968 (1a; 404 F.2d 450), reversed with full awareness (5a) of the rule enounced in this Court's decision in *Graham v. John Deere Co.*, (1966) 383 U.S. 1. It held that upon the evidence in the record the claimed invention was not an obvious one to men of ordinary skill in the art and that the combination of elements as claimed did lead to a new result (7-10a). Petitioner here simply asks this Court to reach a different conclusion on the evidence.

2. The history of the art:

The construction of highways, including the laying of bituminous pavement — often called "black-top" — is notoriously old. The bituminous material is ordinarily delivered to a front hopper of a mobile bituminous paver which then spreads the mix across the base upon which the paver travels, and thereafter shapes the mix to a desired contour (26-7a).

Bituminous pavers are ordinarily unable to lay the full width of a roadway, and it is, therefore, the com-

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mon practice to lay parallel side-by-side lanes, thereby to cover the full width desired. While it is theoretically possible to lay the several lanes almost simultaneously with several pavers running in tandem, one a few feet behind the other, such an arrangement is often impractical because of lack of several machines or because of a need to maintain traffic during construction (30a). It is common, therefore, that one lane be laid some time before the other lane is laid contiguous to it (30a, 44a). The result is that the edge of the material cools before the material in the second course can be laid against it. In those circumstances there is an inadequate bond between the material in the two lanes causing what is known as a "cold joint".

Cold joints have long been troublesome in the laying of bituminous pavements (33-4a, 35-6a, 50-1a). The discontinuity of the cold joint permits infiltration of water and dirt, freezing and thawing, raveling at the joint and eventual disintegration of the pavement.

Numerous expedients have been adopted in an effort to overcome the problem inherent in cold joints, none of them successful (50-1a). One expedient has been to cut back several inches from the edge of the previously laid bituminous material and then to paint the exposed edge with an asphalt material. Cutting back and painting the exposed edge with hot asphalt has traditionally been thought of as the best way of overcoming the cold joint problem, but it has been far from a successful cure. It disturbs the structural strength of the material and, in fact, builds a joint into the pavement (31-3a).

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3. The patent in suit:

Neville patent 3,055,280 makes reference to the manner in which the invention permits construction of a "continuous surface free of fissures and surface defects" (col. 2, lines 61-5).*

The embodiment of the invention that is of interest herein is illustrated in Figures 10, 11 and 12 of the patent drawings. The Neville patent teaches the use of what Neville called "penetrative radiant energy". He taught that use of such energy upon the edge of the previously laid course (or lane) just before placing the abutting course, as shown in Figures 10 and 11, would overcome the problem of cold joints (col. 3, lines 43-52; col. 7, line 38 to col. 8, line 16). For that purpose he positioned a radiant energy generator upon the side of a bituminous paver to direct energy downward to the margin of the previously placed bituminous material just prior to laying the abutting lane. Neville required that his generator be one in which there is a perforate member upon the lower surface and that a fuel gas be burned adjacent that surface to raise the perforate member to a high temperature and develop a deeply penetrating radiant energy. He proposed the use of a burner devised by another (col. 4, lines 65-9; col. 5, lines 9-32).

Claim 4 (col. 10, lines 25-45) is detailed and specific to the apparatus disclosed by Neville. The claim requires the presence of each of (i) a penetrative radiant energy generator, (ii) bituminous material placing means, and (iii) pavement shaping means. The claim further re-

*References here are to the Neville patent.

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quires that the radiant energy generator include an enclosed member having a perforate lower surface and that a fuel gas be passed outwardly through the perforations and combusted adjacent the perforate member (18-9a).

4. The impact of the invention in the art:

After Mr. Neville had made his invention, he sought to interest proper officials in his discovery. Since Mr. Neville died prior to the trial, his meetings with those officials have necessarily been reflected through their testimony.

Mr. Neville approached Mr. Witkoski, who was then Director of Research of the Pennsylvania Department of Highways, and told him of the new equipment which he had devised. Mr. Witkoski simply did not believe the truth of what he was told (35a). Mr. Crowley had long experience, access to all of the knowledge and skills of the Air Force, and a responsibility for maintenance and construction of its vast investment in airfields (48a). Mr. Neville disclosed his invention to Mr. Crowley, who became mildly interested. He did not, however, become interested enough to pursue the matter, however, because he did not believe the equipment would work (49a).

5. The invention produces a new result:

Cores taken from joints formed by laying bituminous material in the conventional manner and those formed with the use of joint heaters show radically different results. Use of the joint heaters makes it impossible to find the joint in the core (51a), whereas a joint appears between parallel lanes laid down using only a conventional paver. The use of joint heaters is

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now a standard requirement for laying of bituminous pavement by the Air Force (Crowley deposition, p. 14) and is required by the State Road Commission of West Virginia (44a).

Aeroil has distributed various catalogs to municipalities and paving contractors in which it has not only stated succinctly the problem faced by Neville, but has also put forward his solution as *the* effective solution. In its Pavers' Digest for March, 1963 (Ex. Vol., E 11) it stated:

"Infra-red joint sealing is fast being written into asphalt highway specs by engineers that are aware of joint problems and why they occur. A truly homogeneous joint is obtained by using the Aeroil HE-PR-8DL. Recent orders from Sweden, Israel and Australia indicate the world-wide interest in this new approach to an old problem."

In that portion of its Municipal and Pavers Catalog dealing with joint sealers (Ex. Vol., E20) Aeroil stated:

"The Joint Sealer is suspended from the side of the paving machine, heating the edge of the previously laid asphalt to secure a perfect bond."

In another of its bulletins Aeroil stated (Ex. Vol. E 28):

"INFRA-RED

"PERMANENT ASPHALT REPAIR

"This remarkable new development is a dramatic break-through in asphalt highway and road maintenance. INFRA-RED heat is not new, but *the application is revolutionary*. The INFRA-RED process softens the asphalt without burning the surface. It elimi-

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nates the necessity of repair of the same chuck holes, cracks, and joints every year. Resurface only once with INFRA-RED and the repair is PERMANENT." [Italics supplied].

Use of the whole combination allows the defendant to pave adjacent lanes on separate days (44a). When it uses the paver alone without the radiant energy generator (less than the whole combination) it cannot do so, "you lose an hour's time at least in lost production", (Trial Transcript 173).

*Argument.***ARGUMENT****— I —**

The entire record shows (i) that the claimed combination produces a new and useful result not produced by the separate elements of the combination; (ii) that the combination is not anticipated; and (iii) that the combination was not obvious to men of greater than ordinary skill in the art.

The court of appeals recognized that the claim is directed to a combination of elements which, in combination, eliminate cold joints. Pursuant to the rule of *Graham v. John Deere Co.*, 383 U.S. 1, 12-17, it made a determination of the scope and content of the prior art and found the prior art to be wanting (9a). It considered differences between the prior art and the claims at issue finding the prior art to be no more than a "junk pile". (9a). Finally, the court of appeals considered the level of ordinary skill in the pertinent art and found it to be wanting (8a, 9-10a). The Morcom patent relied upon by petitioner does not teach the claimed combination (40-42a), and that fact was clearly understood by the court of appeals.

It is plain from the undisputed facts that each of the requirements of 35 U.S.C. § §101, 102 and 103 is fully met; and the court of appeals correctly held the patent valid.

Petitioner's brief purports to finding a conflict between the decision below and *Lincoln Engineering Co. v. Stewart-Warner Corp.*, (1939) 303 U.S. 545. The reliance upon that case is misplaced. That decision holds (p. 549) that a mere aggregation of old parts which

Argument.

in aggregation perform or produce no new or different function is not patentable. The decision is entirely consistent with this Court's recent decision in *Graham v. John Deere Co.* and the decision of the court of appeals herein.

Lincoln Engineering v. Stewart-Warner Corp., holds (p. 549) that the mere improvement of one element of an old combination does not justify a repatenting of the entire old combination with the new element substituted for an old element. That situation does not arise in the present case, since the combination *per se* is a new one. It is never been suggested at any time herein that the inventor made an improvement in one element of a previously existing combination.

The remaining cases cited by petitioner are no more apposite. They involved an effort to claim an old combination in which a single element has subsequently been improved, or else a mere congeries of old elements which do not perform any new or different function when they are brought together. The evidence here shows that the Neville combination was novel and that the combination is greater than the sum of its parts.

—II—

It is immaterial that each element of the Neville claims is old. Such was the situation in *United States v. Adams*, (1966) 383 U.S. 39 in which it was explicitly found at the trial that each separate element of the several claims was individually old, (Ct. Cl., 1964) 330 F.2d 622, 632. But Adams's claimed combination was novel, was not obvious, and produced a new result. Accordingly, the patent was held valid both by the Court of Claims and by this Court.

Argument.

It is recognized, expressly in the opinion of the court of appeals (7-8a) and tacitly in the opinion of the district court (18a) that Neville's claimed combination produces a new result (i.e., the elimination of cold joints, pages 6-9, *supra*); was not anticipated by the prior art; and was not made obvious by the prior art. The fact that the elements of the combination are separately old does not mitigate against patentability.

Conclusion.

CONCLUSION

The decision below should be affirmed.

Respectfully submitted,
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June 20, 1969

